



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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R-2000-136

DEC 13 2000

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading question 39 of the morning section and questions 15 and 16 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner originally scored 68. On June 28, 2000, petitioner requested regrading, arguing that the model answers were incorrect. On June 30, 2000, the Office revised the petitioner's score to 69 because it has been concluded that answers (A), (B), and (C) of question 15 in the afternoon session will be accepted as correct and one point was added to the petitioner's score. This decision is based on petitioner's score of 69 and the regrading of question 39 of the morning section and question 16 of the afternoon section.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded no additional points on the Examination. No credit has been awarded for morning question 39 and afternoon question 16. Petitioner's arguments for these questions are addressed individually below.

Morning question 39 reads as follows:

39. Impermissible recapture in an application exists _____

(A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.

(C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

(D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.

(E) None of the above.

The model answer is choice (C).

Selection (C) is the most correct as per MPEP 1412.02 Recapture. As to (A), recapture occurs when the claim is broadened. Adding a limitation would narrow the claim. As to (B), recapture does not apply to continuations. As to (D), the two-year date relates to broadening reissue applications, not to the issue of recapture. 35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues: "No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent." (E) is incorrect because a (C) is correct.

Petitioner argues that answer (E) is correct because statement in answer (C) is not true. Petitioner contends that the only edition of the MPEP available at the time of the April 12, 2000 exam is the unrevised MPEP seventh edition which includes no discussion that impermissible recapture occurs in a reissue where the omitted or broadened limitation was argued in the original application to make the claims allowable over a rejection or objection. Petitioner further maintains that broadening a limitation added during reissue nevertheless narrows the claim relative to the original claim and narrowing the claim is not impermissible recapture. Petitioner concludes that answer (E) is correct as declaring that the other answers are incorrect.

Petitioner's argument has been fully considered but is not persuasive. The examination instructions specifically state that the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. As explained in *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998), arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. Accordingly, case law had modified the PTO rules of practice, rendering arguments alone as a cause for surrender of subject matter under recapture.

Contrary to petitioner's statement that broadening a limitation added during reissue nevertheless narrows the claim relative to the original claim and narrowing the claim is not impermissible recapture, the question specifically states that impermissible recapture exists if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or

objection made in the parent application. As explained in the instructions, do not assume any additional facts not presented in the questions. Accordingly, the question does not state that such limitation is added during reissue, only that the limitation is broadened during reissue, rendering such broadening impermissible recapture. The statement in answer (C) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

(A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.

(B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

(C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.

(D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.

(E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice (B).

Selection (B) is correct as per *The International Glass Company, Inc. v. United States*, 159 USPQ 434 (US Cl Ct, 1968); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986); *Newell Cos. v. Kenney Mfg.*, 9 USPQ2d 1417 (Fed. Cir. 1988); *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977 (Fed. Cir. 1998). Statement (A) is not correct because, although nearly simultaneous invention may be a factor in making an obviousness determination, it does not in itself preclude patentability. *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed. Cir. 1983). Statements (C) and (D) are incorrect because nearly simultaneous invention bears on neither long-felt need nor commercial success. Statement (E) is incorrect because statement (B) is correct.

Petitioner argues that the correct answer is (E). Petitioner contends that the MPEP § 2141.03 does not discuss simultaneous inventions and the cases, *Merck*, and *Newell*, were not discussed in the MPEP as a precedent for determining the level of ordinary skill in the art.

Petitioner's argument has been fully considered but is not persuasive. As indicated in the instructions, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by a subsequent court decision** or a notice in the *Official Gazette*. The cases cited above are clearly applicable on the issue of whether nearly

contemporaneous invention is evidence of the level of skill in the art. The MPEP revisions are merely an additional place where the existing case law is recorded, but any purported absence of case law from the MPEP in no way negates the effect of case law.

The *Merck* case stated at 380, “[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of ‘the level of knowledge in the art at the time the invention was made.’ *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983).” *Monarch Knitting* stated “[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art” at 1983, referring to *Merck*. Furthermore, “[t]he fact of near[-]simultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art.” *The International Glass Company, Inc. v. United States*, 159 USPQ 434, 443 (US Cl.Ct., 1968). Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention, rendering the statement in answer (B) correct and therefore answer (E) incorrect because (B) is correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy